

REMARKS

Claims 1-17 are pending in the application. Claims 18 and 19 have been added. Claims 1-5, 10, 12 and 14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Chi *et al.* (U.S. Patent No. 5,121,258) (“Chi”). Claims 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chi *et al.* in view of Bonyhard (U.S. Patent No. 6,181,492) (“Bonyhard”). Claims 6, 7, 11, 13, 15 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chi in view of Ishida *et al.* (U.S. Patent No. 6,347,016) (“Ishida”). Applicant submits the following to traverse the prior art rejections.

In the Final Office Action, the Examiner argues that Fig. 2 of Chi *et al.* shows the surfaces 48, 50 of the masters as being in “vertically in close contact with a slave disk 52.” Applicant submits that in FIG. 2 and in the textual description of FIG. 2, (col. 5, lines 22-41), there is no disclosure or suggestion of the master and the slave disks as being in a vertical orientation.

Although, the Examiner states that “merely changing the orientation of the master and the slave without unexpected results [] is a mere rearrangement or reconfiguration of parts,”

Applicant disagrees because:

[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

M.P.E.P. § 2144.04 VI C. In the Office Action, the Examiner has not provided any sort of motivation or reason why one skilled in the art would orient the claimed master carrier and the

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slave carrier as recited in claims 1 and 17, and thus, Applicant submits that claims 1 and 17 are patentable. Likewise, claim 2 is patentable because the Examiner has failed to provide the motivation or reason to support the finding wherein said slave medium is conveyed to a position for close contact with said master carrier, in combination with other elements of the claim.

Claims 8 and 10-12, which depend from claim 1, and claims 3, 13, and 14, which depend from claim 2, are patentable for at least the reasons submitted for their respective base claims. Claims 4 and 5 are patentable for the reasons submitted for claims 1 and 2. Claim 9, which depends from claim 4, and claims 6, 7, 15, and 16, which depend from claim 5, are patentable for at least the reasons submitted for their respective base claims.

Alternatively, or in addition, Applicant submits that claims 12 and 14 are patentable because Chi fails to disclose or suggest generating a transfer magnetic field at at least one side of the slave medium wherein the transfer magnetic field is applied in a direction parallel to a tracking direction of the slave medium. The sections of Chi cited by the Examiner states that “the electromagnet 12 which consequently generates a magnetic transfer field in the contact-transfer zone *between the tips 20, 32a of the pole pieces 18, 32.*” Col. 4, lines 56-60 (emphasis added). In other words, Chi discloses a magnetic field that is generated in a direction perpendicular to the surface of the master and slave mediums that is *not parallel* to the tracking directions of the slave medium. Therefore, claims 12 and 14 are patentable.

Lastly, Applicant requests the Examiner to address the Applicant’s arguments regarding the lack of motivation to combine Chi and Ishida. In the Final Office Action, the Examiner has not demonstrated that a pin as disclosed by Chi and a bolt as disclosed by Ishida are recognized

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in the relevant art as interchangeable. Thus, one skilled in the art would not modify the disclosure of Chi with Ishida to render the claims obvious.

New claims 18 and 19 are added and do not add new matter. Claim 18 is patentable because the references fail to teach, suggest, or provide motivation for the concavo-convex micro-patterns as claimed. According to the present invention, the quantity of dust adhering to a master carrier and a slave medium is reduced by conveying the slave medium in such a manner that a recording surface thereof faces vertically toward a master carrier, held in such a manner that an information-bearing surface thereof faces vertically. If the information-bearing surface of the master carrier has concavo-convex micro-patterns, dust particles are easily trapped in the concavities of the concavo-convex micro-patterns. In this case, the advantage obtained by holding the master carrier in such a manner that the information-bearing surface thereof is held vertically according to the present invention is more apparent.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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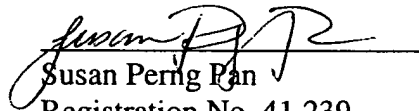
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